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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/215,804	12/18/1998	MARK GAVIN	D3239-00002	1595
8933	7590	04/05/2005	EXAMINER	
DUANE MORRIS, LLP IP DEPARTMENT ONE LIBERTY PLACE PHILADELPHIA, PA 19103-7396			BASHORE, WILLIAM L	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/215,804

Applicant(s)

GAVIN ET AL.

Examiner

William L. Bashore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6,8-14,16-22,24 and 25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-14,16-22,24 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is responsive to communications: amendment filed 6/18/2004, to the original application filed 12/18/1998.
2. The rejection of claims 1-6, 8-14, 16-22, 24-25 under 35 U.S.C. 103(a) as being unpatentable over Anderson, has been withdrawn as necessitated by amendment.
3. Claims 1-6, 8-14, 16-22, 24-30 pending. Claims 26-30 have been added. Claims 1, 5, 9, 13, 17, 21, 25, 26 are independent claims.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. The claimed invention, as claimed in claims 5-6, 8, 13-14, 16, 21-22, 24, 25 is directed to non-statutory subject matter.

In regard to independent claims 5, 13, 21, 25, 26, the combined limitations within each of said claims can be fairly interpreted as a series of mental and/or manual steps (i.e. manually redacting from a printed document, or printed PDF file, mentally parsing, a manual system, etc.), and is therefore directed to non-statutory subject matter. The examiner's suggestion of amending the preamble of each claim to read "*A computer implemented method...*" or "*A computer implemented system...*" will serve to overcome this rejection.

In regard to dependent claims 6, 8, 14, 16, 22, 24, 27, claims 6, 8, 14, 16, 22, 24, 27 are rejected for fully incorporating the deficiencies of their respective base claims.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-6, 8-14, 16-22, 24-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al. (hereinafter Anderson), U.S. Patent No. 5,581,682 issued December 3, 1996, in view of Redax (hereinafter Redax), Web article by Digital Applications, Inc., downloaded on 3/10/2005, with a last update of 12/13/1997, downloaded from <<http://web.archive.org/web/19971221013620/http://digapp.com/>>, pages 1-2.

In regard to independent claim 1, Anderson teaches annotation and redaction of a final-form electronic document (Anderson Abstract; compare with claim 1 preamble "*A method of redacting content from a document in electronic form, comprising the steps of*").

Anderson teaches an Image Object, a Presentation Object, an Overlay Object, and a Graphics Object, comprising geometric areas of a page, with said Overlay Object comprising an annotation or area of content to be redacted (Anderson Figures 1, 3B, 5 also column 3 lines 33-39, column 7 Table II line "Object Area Position"; compare with claim 1 "*selecting a geometric area on the document for redaction, said geometric area having content*", and "*representing said geometric area as one or more annotation objects*"). Anderson does not specifically teach said Overlay Object annotation as a source for redaction. However, this limitation would have

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been obvious to one of ordinary skill in the art at the time of the invention, in view of Anderson, because Anderson teaches annotations and redactions utilizing overlays with redaction security levels, suggesting an applied annotation which can be redacted to reflect a higher security level needed, providing the advantage of increased document security (Anderson Figure 3B, column 5 lines 3-15).

Anderson teaches identification of information representing content/location/nature of content, said information represented as objects (Anderson Figure 1, 3B, also column 6 lines 15-20; compare with claim 1 *“identifying information in the document representing content and location and nature of content”*, and *“representing said identified information as one or more content objects”*).

Anderson teaches a final-form document with annotated and/or redacted areas present in said document, with content replaced with an opaque overlay (redaction) (Anderson Abstract, column 2 lines 25-30, column 5 lines 47-52; compare with claim 1 *“identifying content....to produce a redacted document.”*).

Anderson teaches that, although the underlying original archived document is not changed, a reviewer with a low security clearance may see only the displayed redacted version of said document (Anderson column 2 lines 43-47). Anderson does not specifically disclose “an output file” with said content not present, hence allowing a redacted document to be producible from said output file. However, Redax teaches a method of redacting an electronic PDF document, whereby a redacted document is saved in final redacted form (Redax page 1 paragraph 3). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Redax to Anderson, providing Anderson the benefit of saving the displayed redactions within a final pdf document for portability reasons (i.e. law firms submitting briefs to the U.S. courts with redacted private information from public documents - see Redax page 1 paragraph 2) (compare with claim 1 *“creating an electronic output file, said identified content not present in said output file, a redacted document being reproducible from said output file for display.”*). Applying Redax would also provide ultimate security by preventing any possibility of reverse engineering to reveal sensitive content.

**In regard to dependent claims 2, 3, Anderson teaches items of information (including text) associated with an annotation object (Anderson column 6 lines 12-21; compare with claims 2, 3).**

In regard to dependent claim 4, Anderson teaches a final-form document with annotated and/or redacted are present in said document, content replaced with an opaque overlay (redaction) (Anderson Abstract, column 2 lines 25-30, column 5 lines 47-52; compare with claim 4).

In regard to independent claim 5, Anderson teaches annotation and redaction of a final-form electronic document (Anderson Abstract; compare with claim 5 preamble "*A method of designating portions of a document for redaction, comprising the steps of*").

Anderson teaches displaying a document (Anderson column 6 lines 3-10; compare with claim 5 "*displaying all or a portion of the document*").

Anderson teaches an Image Object, a Presentation Object, an Overlay Object, and a Graphics Object, comprising geometric areas of a page, with said Overlay Object comprising an annotation or redaction (Anderson Figures 1, 3B, 5, also column 3 lines 33-39, column 7 Table II line "Object Area Position"; compare with claim 5 "*designating a geographical region of the document for redaction*"). Anderson does not specifically teach said Overlay Object annotation as a source for redaction. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Anderson, because Anderson teaches annotations and redactions utilizing overlays, with redaction security levels, suggesting an applied annotation which can be redacted to reflect a higher security level needed, providing the advantage of increased document security (Anderson Figure 3B, column 5 lines 3-15).

Anderson teaches identification of information representing content/location/nature of content, said information represented as objects producing a final-form document with annotated and/or redacted areas are present in said document (Anderson Abstract, column 2 lines 25-30, Figure 1, 3B, also column 6 lines 15-20, column 5 lines 47-52). Anderson does not specifically disclose "*saving*" designations with the document, hence allowing a redacted document to be producible from said output file. However, Redax teaches a method of redacting an electronic PDF document, whereby a redacted document is saved in final redacted form (Redax page 1 paragraph 3; compare with claim 5 "*saving the designations with the document*"). It would have been

obvious to one of ordinary skill in the art at the time of the invention to apply Redax to Anderson, providing Anderson the benefit of saving the displayed (designated) redactions within a final pdf document for portability reasons (i.e. law firms submitting briefs to the U.S. courts with redacted private information from public documents - see Redax page 1 paragraph 2). Applying Redax would also provide ultimate security by preventing any possibility of reverse engineering to reveal sensitive content.

Anderson teaches a user specifying a location and orientation of annotation content within a dimensioned box on a final-form document (Anderson column 6 lines 12-20, Figure 3A-3B, 4; compare with claim 5 “*wherein the step of designating comprises manipulating a frame displayed on the document, content... visible to the user during said step of manipulation.*”), teaching the manipulation and orientation (framing) of an object on a page.

Applying the above limitation regarding manipulation of a frame, to a redaction, would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Anderson, because Anderson teaches application of overlays to both annotations and redactions (see Anderson Figure 5). Since a document annotation can be subject to redaction, it would have been obvious to add and/or combine the redaction overlay with the annotation overlay, providing the advantage of extra security via redaction of user annotations.

**In regard to dependent claim 6,** Anderson teaches the use of descriptions and stored as offsets (Anderson columns 4 lines 12-24, columns 6-9 Tables I - III; compare with claim 6).

**In regard to dependent claim 8,** Anderson does not specifically teach batch designation. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Anderson, because Anderson teaches “include” structures within a page, with more than one include structure per page (for each annotation/redaction) (Anderson column 3 lines 40-48). Anderson also teaches a state register set if default is for a user to view all annotations on a page (Anderson column 5 lines 28-35; compare the above with claim 8), suggesting the processing of annotations/redactions as performed in a batch manner, providing the advantage of efficient batch (all at once) processing.

**In regard to claims 9-12**, claims 9-12 reflect the medium comprising computer executable instructions used for performing the methods as claimed in claims 1-4, and are rejected along the same rationale.

**In regard to claims 13-14, 16**, claims 13-14, 16 reflect the medium comprising computer executable instructions used for performing the methods as claimed in claims 5-6, 8, and are rejected along the same rationale.

**In regard to claims 17-20**, claims 17-20 reflect the system comprising computer executable instructions used for performing the methods as claimed in claims 1-4, and are rejected along the same rationale.

**In regard to claims 21-22, 24**, claims 21-22, 24 reflect the system comprising computer executable instructions used for performing the methods as claimed in claims 5-6, 8, and are rejected along the same rationale.

**In regard to independent claim 25**, Anderson teaches annotation and redaction of an electronic document (Anderson Abstract; compare with claim 25 preamble "*A method of designating portions of a document for redaction, comprising the steps of*").

Anderson teaches displaying a document (Anderson column 6 lines 3-10; compare with claim 25 "*displaying all or a portion of the document*").

Anderson teaches an Image Object, a Presentation Object, an Overlay Object, and a Graphics Object, comprising geometric areas of a page, with said Overlay Object comprising an annotation (Anderson Figure 1, 3B, also column 3 lines 33-39, column 7 Table II line "Object Area Position"; compare with claim 25 "*designating a geographical region of the document for redaction*"). Anderson does not specifically teach said Overlay Object annotation as a source for redaction. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Anderson, because Anderson teaches annotations



and redactions utilizing overlays, with redaction security levels, suggesting an applied annotation which can be redacted to reflect a higher security level needed, providing the advantage of increased document security (Anderson Figure 3B, column 5 lines 3-15).

Anderson teaches identification of information representing content/location/nature of content, said information represented as objects producing a final-form document with annotated and/or redacted are present in said document (Anderson Abstract, column 2 lines 25-30, Figure 1, 3B, also column 6 lines 15-20, column 5 lines 47-52). Anderson does not specifically disclose “saving” designations with the document, hence allowing a redacted document to be producible from said output file. However, Redax teaches a method of redacting an electronic PDF document, whereby a redacted document is saved in final redacted form (Redax page 1 paragraph 3; compare with claim 25 “*saving the designations with the document*”). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Redax to Anderson, providing Anderson the benefit of saving the displayed (designated) redactions within a final pdf document for portability reasons (i.e. law firms submitting briefs to the U.S. courts with redacted private information from public documents - see Redax page 1 paragraph 2). Applying Redax would also provide ultimate security by preventing any possibility of reverse engineering to reveal sensitive content.

The limitation regarding batch designation of particular selected content would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Anderson, because Anderson teaches “include” structures within a page, with more than one include structure per page (for each annotation/redaction set that a user creates and/or selects) (Anderson column 3 lines 40-48). Anderson also teaches a state register set if default is for a user to view all annotations on a page (Anderson column 5 lines 28-35; compare the above with claim 25 “*wherein said step of designating comprises designating all geographic regions containing particular content selected by a user for batch designation.*”), suggesting the processing of annotations/redactions as performed in a batch manner of selected content, providing the advantage of batch (all at once) processing.

**In regard to independent claim 26**, claim 26 incorporates substantially similar subject matter as claimed in claim 1, and in further view of the following, is rejected along the same rationale.

Anderson does not specifically teach a PDF file. However, Redax taught redaction as applied to a PDF file (Redax paragraph 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Redax to Anderson, providing Anderson the benefit of redacting PDF documents, increasing the versatility of Anderson as applied to a wider variety of document types.

**In regard to dependent claims 27-30**, Anderson teaches displaying a document (Anderson column 6 lines 3-10; compare with *"displaying all or a portion of a document"*).

Anderson teaches a user specifying a location and orientation of annotation content within a dimensioned box on a final-form document (Anderson column 6 lines 12-20, Figure 3A-3B, 4; compare with *"manipulating a frame displayed on the document, content....visible to the user during said step of manipulation."*), teaching the manipulation and orientation (framing) of an object on a page.

### ***Response to Arguments***

8. Applicant's arguments filed 6/18/2004 have been fully and carefully considered but they are currently moot in view of the new grounds of rejection.

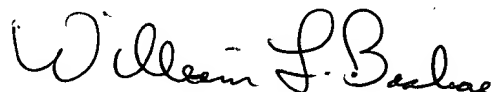
### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L. Bashore whose telephone number is (571) 272-4088. The examiner can normally be reached on 11:30am - 8:00pm EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



WILLIAM L. BASHORE  
PATENT EXAMINER  
TECH CENTER 2100

April 1, 2005